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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

01/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,464

Applicant(s)

FOLTZ-SMITH ET AL.

Examiner

NATHAN C. UBER

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 20 October 2008.
2. Claims 22-63 have been added.
3. Claims 1-21 have been withdrawn.
4. Claims 22-63 are currently pending and have been examined.

Claim Objections

5. Claims 10-12 were objected to in the previous Office action. Claims 10-12 were withdrawn from consideration therefore the rejections with respect to claims 10-12 have been provisionally removed but will be reinstated if the claims are ever reinstated for examination.

Claim Rejections - 35 USC § 112

6. Claim 9 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 was withdrawn from consideration therefore the rejection with respect to claim 9 has been provisionally removed but will be reinstated if the claim is ever reinstated for examination.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 22, 46 and 61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The

claims recite *modules*. Claim 22 narrowly defines the modules as a set of data, however neither the original claims nor the specification disclose modules. This limitation therefore constitutes impermissible new matter. Examiner further notes that the limitation module is broad and may be reasonably interpreted to constitute more than a set of data in the context of claims 46 and 61 because claims 46 and 61 do not depend from claim 22. Because the original disclosure offers no guidance for the interpretation of *module* in the claims, the limitation is construed as broadly and constitutes impermissible new matter.

9. Claims 30, 42 and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The claims recite *the advertiser data determines which search results are extracted by the search engine*. Neither the original claims nor the specification disclose this feature. This limitation constitutes impermissible new matter.
10. Claims 34 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The claims recite *operating a search engine to extract a plurality of search result from the advertiser entries based on the sales category and the geographic location data*. Neither the original claims nor the specification disclose the limitations *sales category* and *geographic location data*. Further the original disclosure does not contemplate *extracting data based on* the above limitations. Claims 34 and 39 also recite *mapping the query to at least one sales category among a plurality of sales categories*. Neither the original claims nor the specification disclose the limitations *sales category* and *geographic location data* and further the original disclosure does not contemplate *mapping* search queries; the only "mapping" feature in the original disclosure is concerned with identifying business locations on a geographical map. *Mapping* search queries is a much broader

concept. Therefore, these limitations constitute impermissible new matter. **Examiner's note:** With regard to that above new matter rejection of the *geographic location data* limitation, Examiner recognizes that the specification discloses and defines *coverage area*, *geographic region of consideration* and *single-location/multiple-location sponsor*. Further examiner understands that *geographic location data* may be understood to be synonymous or descriptive of the above terms. However, under MPEP § 2111 Examiner must interpret *geographic location data* broadly, and this limitation when interpreted reasonably broad constitutes additional information/concepts that are not disclosed in the specification. Because this new limitation is not narrowly defined in the specification, Examiner must interpret this new limitation as impermissibly broader than the original disclosure.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 30, 42 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites *the advertiser data determines which search results are extracted by the search engine*. It is neither disclosed in the specification, nor understood in the art, how data can make determinations. Usually only human operators or computer processors can make determinations.
13. Claims 31, 46 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31, 46 and 61 are specifically directed to a *geolocation module*. Claim 22 broadly discloses a plurality of modules and defines these modules as data, it recites *a set of data... the set of data including* then lists the modules among other elements data. This is the only definition of *module* in the entire disclosure and the term module was not part of the original disclosure, so Examiner relies on this definition when interpreting the subsequent claims even though claims 46 and 61 do not depend from claim 22. In Claims 31, 46, and 61, however,

Applicant claims the geolocation module as a component of the system, method or computer-readable medium with the language *the system/method/computer readable medium... further comprising: a geolocation module*. It is not known in the art how a set of data may comprise a structural component (as in claim 31), a step of a method (as in claim 46), or a feature/component of a computer-readable medium (as in claim 61). Because the disclosure does not clarify for one having ordinary skill in the art how data may on its own have structural integrity, comprise an active step in a method or comprise a feature (structural or functional) of a computer-readable medium, the claims are indefinite. For the purposes of this examination, *module* is interpreted to mean data as defined in Claim 22.

Claim Rejections - 35 USC § 101

14. Claim 9 was rejected under 35 USC 101 in the previous Office action. Claim 9 was withdrawn from consideration therefore the rejection with respect to claim 9 has been provisionally removed but will be reinstated if the claim is ever reinstated for examination.
15. Claim 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 34 fails to meet the above requirements because it is neither transforms underlying subject matter nor is it tied to a second statutory class of invention. The steps of *receiving* and *transmitting* are considered insignificant extra-solution activity, so whether or not the *network* constitutes a second statutory class of invention is moot. The preamble recitation *a computer-based method* does not satisfy the

requirement because the preamble lends no patentable weight to the claim. The limitation *operating a search engine* does not satisfy the requirement because a human operator may complete this step and satisfy the claim and human operators are not statutory classes of invention. Examiner notes that the search engine here completes the "extraction of results" but this step is not positively recited in the claim, only the step of *operating* is positively recited. It must be evident in the body of the method claim that a second statutory class of invention is tied to the method in a significant way.

16. Claim 49 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The *computer-readable medium having stored thereon a set of data that is at least readable by a processor of a computer to execute a method* of Claim 49 is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Here the "data" has no functionality because it is only "readable" by a computer. The data may be able to execute a method (such as a list of instructions or printed computer code), but in this claim the data is merely stored on the medium such that it is readable and not executable. To be statutory the data must be executable. Examiner recommends the following: "a computer-executable program product tangibly embodied on a computer readable medium." For the purposes of this examination, this claim and its dependents are interpreted as method claims because the bodies of the claims reflect the format of method claims.

Claim Rejections - 35 USC § 102

17. Claims 1-12 were rejected under 35 U.S.C. 102(b) as being anticipated by Cheung et al. (U.S. 2003/0028529). Claims 1-12 were withdrawn from consideration therefore the rejections with respect to claims 1-12 have been provisionally removed but will be reinstated if the claims are ever reinstated for examination.

Claim Rejections - 35 USC § 103

18. Claims 13-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Leishman et al. (U.S. 2004/0073538) in view of Cheung et al. (U.S. 2003/0028529). Claims 13-21 were withdrawn from consideration therefore the rejections with respect to claims 13-21 have been provisionally removed but will be reinstated if the claims are ever reinstated for examination.
19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
21. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
22. Claims 22-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al. (U.S. 2003/0028529) in view of Leishman et al. (U.S. 2004/0073538).

Claim 22:

Examiner's Note: Applicant properly claims a system in the claim below, however the system of this claim is extremely broad as it is only limited to a processor and a medium containing data that the processor is at least capable of reading. This system can for example describe a scanner (processor) with a piece of paper containing data (the medium) on the scanning portion of the scanner (readable). There is no functional relationship between the data in this claim and the processor or the medium. In this situation patentable weight is not given to the data elements in the claim because the data is not functional but merely descriptive. See "Non-Functional Descriptive Material," MPEP 2106. Nevertheless, Examiner maintains, as in the previous Office action, that the cited art of record discloses the limitations below whether or not the limitations carry patentable weight in the claim.

Cheung, as shown, discloses the following limitations:

- *at least one processor (see at least ¶0040, a server),*
- *a medium connected to the processor (see at least ¶0040, a communications medium, the internet),*
- *a set of data on the medium and being at least readable by the processor the set of data including: advertiser payment information; a query receiving module to receive a search query over a network from a user computer system; geographic data of a location; a mapping module to map the query to at least one sales category among a plurality of sales categories; an advertiser data store including a plurality of advertiser entries; a search engine to extract a plurality of search result from the advertiser entries based on the sales category and the geographic location data; a ranking module to rank the search results based on at least the advertiser payment information into a ranked set of search results; and a transmission module to transmit the set of ranked search results over a network to the user computer system, each one of the ranked search results including a link to retrieve a respective*

advertiser web page over a network from a respective advertiser computer system utilizing the user computer system (see at least Figure 1, items 102 search engine, 104 search results database and 105 account database, databases inherently include the functionality of ranking and categorizing/mapping to a category", see also at least figure 4, networking functionality),

Cheung does not specifically disclose *geographic data of a location* however Leishman discloses location information (see at least ¶0044) and more general geographic information (see at least ¶¶0032 and 0041). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional data of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 23, 35 and 50:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *wherein the ranking is dependent upon whether a link included in an ad has received a predetermined number of clicks within a predetermined period of time (see at least ¶0139, when the account is exhausted the ad is no longer positioned with the paid advertisements/displayed, see also at least ¶¶0124 and 0048).*

Claims 24, 36 and 51:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *a sponsor is an advertiser that has a financial agreement with the search provider regarding the inclusion of the sponsor's ad on the search provider's web page (see at least ¶0047, advertiser opens an account),*
- *a non-sponsor is an advertiser whose ad is displayed on the search provider's web page free of charge (see at least ¶0048, non paid website descriptions/listings),*
- *non-sponsors' ads are displayed in a region of the search provider's web page below another region of the search provider's web page where sponsors' ads are displayed (see at least ¶0048, non paid listings appear separately or at the bottom of paid listings).*

Claims 25, 37 and 52:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *the search provider is due a fee from a sponsor every time a user selects a link associated with the sponsor's ad displayed on the search provider's web page (see at least ¶0117, "a money amount that is deducted from the account of the advertiser for each time the advertiser's web site is accessed via a hyperlink on the search result page").*

Claims 26, 38 and 53:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *the sponsor's ad has associated with it a cap amount that is the maximum amount of money that a sponsor can be billed by the search provider for the sponsor's ad within a billing cycle (see at least ¶0124, advertise may prepay for clicks).*

Claims 27, 39 and 54:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *a location where the sponsor's ad is displayed on the search provider's web page is influenced by a difference between the cap amount and a total accrued debt owed by the sponsor to the search provider for the sponsor's ad (see at least ¶0124, if there are not enough funds, the advertisement will not appear in the search results).*

Claims 28, 40 and 55:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *the sponsor's ad is located within the region of the search provider's web page with non-sponsors' ads when the total accrued debt owed by the sponsor to the search provider for the sponsor's ad equals the cap amount (see at least ¶0048, non-paid listings appear in a different section or below paid listings, and are retrieved based on relevance to the search).*

Claims 29, 41 and 56:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *the sponsor can change the cap amount (see at least ¶0124, advertiser may add funds).*

Claims 30, 42 and 57:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *the advertiser data determines which search results are extracted by the search engine (see at least ¶0139, when the account is exhausted the ad is no longer positioned with the paid advertisements/displayed see also ¶0124).*

Claims 31, 46 and 61:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Cheung does not specifically disclose the following limitation. However, Leishman, as shown, discloses the following limitation:

- *a geo-location module that determines a location of the user computer system (see at least ¶0030, the polygon search module),*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional data of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 32, 47 and 62:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Cheung does not specifically disclose the following limitation. However, Leishman, as shown, discloses the following limitation:

- *a geo-location module calculating a geographic region of consideration, and removing all sponsor ads from the list of sponsors' ads when the respective sponsor's business location is outside of the geographic region of consideration (see at least ¶0030, the polygon search module),*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional data of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 33, 48 and 63:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Cheung does not specifically disclose the following limitation. However, Leishman, as shown, discloses the following limitation:

- *the geographic region of consideration is a circle having a center point and a radius, and the radius is multiplied by a market multiplier factor that varies as a function of a location of the center point (see at least ¶0030, the polygon search module),*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional data of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 34 and 49:

Cheung, as shown, discloses the following limitations:

- *storing advertiser information on a medium (see at least figure 1, item 105 account database),*
- *storing a plurality of advertiser entries on the medium (see at least figure 1, item 105 account database),*
- *receiving a search query over a network from a user computer system (see at least figure 1, item, 102 search engine, inherently a search engine receives a search query, see also at least ¶0118),*
- *mapping the query to at least one sales category among a plurality of sales categories (see at least ¶0011, cataloging search results),*
- *operating a search engine to extract a plurality of search result from the advertiser entries based on the sales category and the geographic location data (see at least ¶¶0011 and 0118, using a search engine),*

- *rank the search results based on at least the advertiser payment information to a ranked set of search results* (see at least ¶¶0048, the bid amount for the ad dictates the ad placement in the search result list, see also at least ¶¶0117),
- *transmitting the set of ranked search results over a network to the user computer system, each one of the ranked search results including a link to retrieve a respective advertiser web page over a network from a respective advertiser computer system utilizing the user computer system* (see at least ¶¶0014, advertisers pay for click through referrals generated from the search result list generated by the search engine),

Cheung does not specifically disclose *geographic data* however Leishman discloses location information (see at least ¶¶0044) and more general geographic information (see at least ¶¶0032 and 0041). Further Cheung does not specifically disclose the following limitation. However, Leishman, as shown, discloses the following limitation:

- *storing geographic data of a location on the medium* (see at least ¶¶0044),

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional data of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 43 and 58:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitations:

- *calculating a pacing factor* (see at least ¶¶0090, capping accounts by time period),

- *comparing a random number, having a value between zero and one, to the pacing factor for each sponsor's ad (see at least ¶0099),*
- *displaying the sponsor's ad on the search provider's web page only if the pacing factor is greater than the random number (see at least ¶0106, changing account status may result in removal of an ad from search results),*

Cheung discloses projecting expenses predicting the projected number of days until the exhaustion of account funds (see at least ¶139) and creating invoice caps for specific time periods (see at least ¶0090). Further Cheung discloses and account monitoring method capable to removing ads from results tables when thresholds are exceeded (see at least ¶0099). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to implement a pacing factor because Cheung discloses a comparable method.

Claims 44 and 59:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Further, Cheung, as shown, discloses the following limitation:

- *sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the cost-per-click multiplied by the click-through rate associated with each sponsor's ad (see at least ¶0117, sorting the result list based on the amount bid which may be a cost-per-click, see also at least ¶¶0139-0140 maximizing anticipated revenue based on cost-per-click and run rate).*

Claims 45 and 60:

The combination Cheung/Leishman discloses the limitations as shown in the rejection above. Cheung does not specifically disclose the following limitation. However, Leishman, as shown, discloses the following limitation:

- *calculating a sorting factor (see at least ¶0066, sort the result list),*

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- *sorting the sponsors' ads and displaying the sponsors' ads on the search provider's web page according to the sorting factor* (see at least ¶0066, sort the search result list),

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional sorting feature of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

23. Applicant's arguments with respect to claim 1-21 have been considered but are moot in this action because claims 1-21 have been withdrawn from consideration. The rejections of claims 1-21 are provisionally removed but will be reinstated if the claims are ever reinstated for examination as indicated above.
24. Applicant's arguments with respect to claims 22-63 are not persuasive. Applicant argues that the claims "include the limitations of combining local data, sales category mapping and ranking in a unique manner that is not suggested" by Cheung or Leishman. Examiner disagrees. Examiner notes that sales category mapping is new matter and further addresses the data, mapping and ranking elements in the new rejections above.

Conclusion

25. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
29. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

30. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
5 January 2009

/Arthur Duran/
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